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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/610,320 07/05/00 AFRIAT

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022850 HM12/0525  
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EXAMINER

BENNETT, R

ART UNIT

PAPER NUMBER

1615

6

DATE MAILED:

05/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/610,320

Applicant(s)

AFRIAT ET AL.

Examiner

Rachel M. Bennett

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The examiner acknowledges receipt of Information Disclosure Statement filed 7/5/00 and Declaration and Supplemental Disclosure Statement filed 10/5/00.

#### ***Specification***

#### ***Double Patenting***

2. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 09/611663. Although the conflicting claims are not identical, they are not patentably distinct from each other because the aqueous phase of at least 75% in '663 is obvious over '320, wherein the aqueous phase is at least 70%.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is indefinite because applicant does not clearly define "solid composition" in the claims. If the aqueous phase is at least 70% by weight, how can the composition be solid? Clarification is requested.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothroyd et al. (US 5250289), and further in view of Tachibana et al. (US 5412004) and Schulz et al. (US 5811487).

Boothroyd discloses a sunscreen composition, which comprises a water-in-oil emulsion which comprises a) 0.5 to 30% by weight titanium dioxide, b) 5 to 20 % by weight of an oil phase, c) 1 to 15% by weight of an emulsifier, and d) at least 40% by weight of an aqueous phase. Further suncreening agents may be included. The oil phase may be a wax, natural oil, silicone oil or a mixture. Preferred emulsifiers are silicone emulsifiers such as silicone polyols. Stabilizing salts such as sodium chloride may be added (see abstract and col. 2). The resulting composition is a cream (see examples). Boothroyd fails to teach the crosslinked elastomeric organopolysiloxane.

Tachibana et al. discloses a silicone polymer, a paste-like silicone composition prepared by kneading the silicone polymer and a silicone oil under a shearing force, and a water-in-oil type composition comprising the paste-like silicone composition as an oil phase component (see abstract). Example 3 discloses organohydrogenpolysiloxanes and polyoxyalkylenes and solvents are processed to obtain silicone polymer particles. The paste-like silicone composition is capable of dispersing water stably and homogeneously without using a surfactant. The water-in-oil type cosmetic composition which imparts a fresh sensation upon use without stickness and stable for a long time, and having a superior water repellency and a capability of excellently retaining the makeup without running (see col. 2 lines 3-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the silicone polymer taught by Tachibana for the silicone emulsifiers taught by Boothroyd because of the expectations of achieving a composition which is capable of dispersing water stably and homogeneously without using a surfactant. Also, the water-in-oil cosmetic composition would impart a fresh sensation upon use without stickiness and stable for a long time, and having a superior water repellency and a capability of excellently retaining the makeup without running as taught by Tachibana.

#### *Art of Interest*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schulz et al. (US 5811487) disclose silicone elastomers made by crosslinking siloxanes and unsaturated hydrocarbon. The silicone paste can be easily emulsified with water to form a stable uniform emulsion, without using a surfactant to allow normally immiscible materials to become intimately mixed (abstract). This can be of considerable value in the personal care arena where skin sensitivity due to the presence of certain surfactants can be an issue (see col. 1 lines 28-36). Lin (US 6168782) teaches elastomeric silicone compositions. Catalysts disclosed include platinum.

#### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779. The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 309-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

R. Bennett:RMB *RMB*  
May 22, 2001

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600